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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,275	01/19/2001	Toshio Kobayashi	SHC0104	1331

7590

09/22/2004

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EXAMINER

BOYD, JENNIFER A

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,275

Applicant(s)

KOBAYASHI ET AL.

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed June 29, 2004, have been entered and have been carefully considered. Claims 1 and 2 are amended, claim 7 is added and claims 1 – 3 and 6 are pending. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. Claims 1 – 3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 09/613814 in view of Morman (US 5,681,645). The details of the obvious-type double patenting rejection can be found in paragraph 3 of the previous Office Action dated March 29, 2004. The rejection is maintained.

4. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,372,067 to Kobayashi et al. The details of the obvious-type double patenting rejection can be found in paragraph 4 of the previous Office Action dated March 29, 2004. The rejection is maintained.

5. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,531,014 to Kobayashi. The

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details of the obvious-type double patenting rejection can be found in paragraph 5 of the previous Office Action dated March 29, 2004. The rejection is maintained.

Claim Rejections - 35 USC § 103

6. Claims 1 – 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strack et al. (US 5,681,645) in view of Morman (US 5,681,645). The details of the rejection can be found in paragraph 6 of the previous Office Action dated March 29, 2004. The rejection is maintained.

The Applicant has amended claim 2 to require that the propylene homopolymer is present in the amount of greater than 0% to 90% by weight. The Applicant has added claim 7 requiring that the inelastic sheet comprises ethylene/propylene copolymer containing ethylene at 0.5 – 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 – 10% by weight and butene at 0.5 – 15% by weight, or a mixtures at 100 % by weight

Strack teaches the claimed invention except fails to disclose that the propylene homopolymer is present in the amount of greater than 0 to 90% by weight as required by amended claim 2. Additionally, Strack fails to teach that the component fibers of the sheet having inelastic stretchability comprises ethylene/propylene copolymer containing ethylene at 0.5 – 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 – 10% by weight and butene at 0.5 – 15% by weight, or a mixture thereof at 100 – 10% by weight as required by new claim 7.

Morman describes multi-directional stretch composite elastic material comprising at least one sheet which is stretched and one necked (non-elastic) material, which are joined together in

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at least three locations corresponding to the instantly claimed binding spots (column 3, lines 30-45). Morman describes the non-elastic materials are nonwovens made of polyolefins and similar polymers including ethylene copolymers, propylene copolymers and butene copolymers (column 4, lines 44 - 64). Morman teaches that necked material can also comprise polypropylene (column 7, lines 1 - 10). Morman notes that the neckable material can comprise a mixture of two or more fibers (column 7, lines 30 - 35). Therefore, in one embodiment, fibers can comprise ethylene/propylene/butene copolymers as one fiber type and polypropylene as another fiber type. It should be noted that if polypropylene is present in any amount, it will meet Applicant's requirement of greater than 0%.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to create the non-elastic textile web of Strack with the copolymer and polypropylene fiber combination of Morman motivated by the desire to improved resilience, stretch and recovery of the composite.

Strack in view of Morman discloses the claimed invention except for that the inelastic material comprises ethylene/propylene copolymer containing ethylene at 0.5 - 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 - 10% by weight and butene at 0.5 - 15% by weight, or a mixture thereof at 100 by weight as required by claim 7. It should be noted that the amount of ethylene or ethylene and butene is a result effective variable. For example, as the amount of ethylene increases, the material possess more characteristics similar to ethylene, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the inelastic material comprising ethylene/propylene copolymer containing ethylene at 0.5 - 10% by weight, ethylene/propylene/butene containing ethylene at 0.5 - 10% by

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weight and butene at 0.5 – 15% by weight, or a mixture thereof at 100% by weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the amounts of ethylene or the amounts of ethylene and butene in order to have a properly strong and resilient composite web.

Response to Arguments

7. Applicant's arguments filed June 29, 2004 have been fully considered but they are not persuasive.
8. In response to Applicant's request to hold the obvious-type double patenting rejections in abeyance until the Terminal Disclaimer is submitted, the Examiner has respectfully maintained the rejection until the proper paperwork has been filed.
9. In response to Applicant's argument that the "necked material" is made of polyolefins that is taught to be a component of elastic materials, the Examiner respectfully argues the contrary. Although the Examiner previously incorporated Wisneski (US 4,663,220) to demonstrate the optimization of the copolymer components, the currently standing rejection does not rely on Wisneski as a teaching. Therefore, it is irrelevant that Wisneski teaches that the percentages of the polyolefin copolymers were determined for elastomeric materials rather than inelastic materials. It should be noted that Morman positively teaches that the ***non-elastic materials*** are nonwovens made of polyolefins and similar polymers including ethylene copolymers, propylene copolymers and butene copolymers (column 4, lines 44 - 64). Morman teaches that non-elastic necked material can also comprise polypropylene (column 7, lines 1 –

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10). Morman notes that the non-elastic neckable material can comprise a mixture of two or more fibers (column 7, lines 30 – 35). Because Strack in view of Morman fails to disclose a certain weight percentage for each component, it is held that the percentages are a result of optimization absent any evidence to the contrary. If the claimed ranges have unexpected results, the burden is upon the Applicant to demonstrate that the claimed ranges are not a matter of simple optimization. The Examiner highly suggests to the Applicant to submit a 37 CFR 1.132 Declaration to establish unexpected results. In the Declaration, the Applicant should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960) and must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness.

10. In response to Applicant's argument that the prior art does not teach that after the fibrous assembly is bonded to the elastic sheet the resulting composite is stretched so as to change the dimensions of the fibers in the fibrous assembly and the elastic stretchability of the composite sheet, the Examiner respectfully submits that the fiber dimensions of the fibrous assembly and the elastic stretchability would inherently change in the composite of Strack in view of Mormon since the prior art meets all claimed chemical/structural limitations. If those properties are not inherent, it is asserted that Applicant's claim must be incomplete. In other words, if Applicant's asserts a lack of inherency in Strack in view of Morman, then Applicant's claimed invention is missing an element that is critical to the invention, which would patentably distinguish it from the known prior art.

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Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Boyd

September 15, 2004


Ula C. Ruddock
Primary Examiner
Tech Center 1700